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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,868	07/02/2002	Jacob Wohlstadter	100390-06290	1273
22852	7590	06/14/2006		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
			EXAMINER SINES, BRIAN J	
			ART UNIT 1743	PAPER NUMBER

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/031,868

Applicant(s)

WOHLSTADTER ET AL.

Examiner

Brian J. Sines

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/23/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 66-94 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 66-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of group I comprising claims 66 – 71 in the reply filed on 3/23/2006 is acknowledged. New claims 72 – 94 were added in the response filed 3/23/2006. Claims 66 – 94 will be examined.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 66 – 94 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 4 of Liljestrand et al. (U.S. Patent No. 6,200,531 B1) (hereinafter “Liljestrand”) in view of Ghaed et al. (U.S. Pat. No. 5,466,416 A) (hereinafter “Ghaed”).

Regarding claims 66, 72 and 87, with respect to claim 1 of Liljestrand, Liljestrand teaches an apparatus comprising: a cell having a transparent portion; a working electrode; and a counter electrode. Liljestrand does not specifically teach a heater that is thermally coupled or in thermal contact with the working electrode for adjusting the operating temperature of the working electrode. Liljestrand does not specifically teach a heater that is thermally coupled or in thermal contact with at least one surface of the chamber for adjusting the operating temperature of the chamber, and thereby the operating temperature of the working electrode.

Ghaed does teach that the electrochemiluminescence process is substantially sensitive to the temperature of the sample under test (see col. 6, lines 38 – 49). Ghaed does teach the use of a fluid handling system that has a fluid heater system (see col. 6, lines 49 – 61).

Liljestrand does teach that the electrochemiluminescence process occurs at the working electrode 140 site when testing assay samples (see, e.g., 14, lines 41 – 64).

A person of ordinary skill in the art would have recognized the suitability of using a heating device to control the temperature of the working electrode test site in the disclosed device. A person of ordinary skill in the art would accordingly have had a reasonable expectation for success in incorporating the use of a heating element for effectively inducing and controlling the electrochemiluminescence test process at a working electrode test site in the disclosed apparatus. Therefore, it would have been obvious to a person of ordinary skill in the art to

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incorporate the use of a heater associated with either the working electrode or surface of the chamber proximal to the working electrode as claimed to facilitate effecting heating and temperature control for the disclosed device.

Regarding claims 67, 75, 76, 78 and 85, Liljestrand teaches that the heater is coupled to a temperature controller and sensor (see col. 17, line 60 – col. 18, line 5). Closed loop control methodologies are very well known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate an associated temperature sensor as claimed to facilitate effective temperature control for the disclosed device. In addition, the various recited temperature sensors are very well known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate the use of these sensors with the disclosed device for facilitating effective temperature control.

Claims 68 – 70 and 79 – 84 are considered an intended use recitations. The prior teaches all of the recited structure of the claimed device. Therefore, the prior art device is considered capable of operating in the intended manner.

Regarding claim 71, Liljestrand teaches that heater 216, is thermally coupled to an input fluid in the chamber of the device for temperature control (see col. 17, line 60 – col. 18, line 5).

Regarding claims 73, 74 and 85, Ghaed teaches the use of Peltier devices and resistive foil heaters for providing temperature control (see col. 16, lines 17 – 30). Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate the use of these heating elements with the disclosed device for facilitating effective temperature control. In addition, resistive thin film or foil heating elements are well known in the art to have a thickness of 1 inch or less.

Regarding claim 77, Liljestrand teaches that the sensors may be an integral part of the heater (see col. 18, lines 1 – 3). Therefore, it would have been obvious to a person of ordinary skill in the art to provide a temperature sensor that is an integral component of the heater.

Regarding claims 86 and 90, Liljestrand teaches the incorporation of a photodetector, such as a photodiode (see, e.g., col. 5, lines 32 – 35; col. 6, lines 53 – 65).

Regarding claim 88, Liljestrand teaches the incorporation of a magnetic field generating device (e.g., magnet 146) (see figure 3B; col. 13, lines 46 – 67).

Regarding claim 89, Liljestrand teaches the incorporation of an electrically-shielded window (see, e.g., col. 5, lines 49 – 57).

Regarding claims 91 – 93, Liljestrand teaches the incorporation of a light source that is also capable of avoiding the detection of infrared radiation (see, e.g., col. 8, lines 22 – 34; col. 10, lines 51 – 63).

Regarding claim 94, Liljestrand teaches the incorporation of an optical filter configuration (see, e.g., col. 11, lines 8 – 26).

### ***Conclusion***

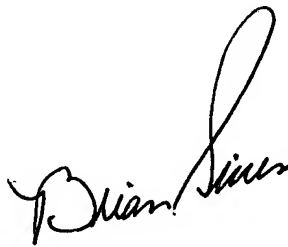
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional cited prior art teach various devices for conducting electrochemiluminescence test measurements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11 AM - 8 PM EST).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Brian Sines". The signature is written in a cursive, flowing style with a large loop at the end of the last name.